REMARKS

1.   Summary of the Office Action

In the non-final Office Action mailed October 27, 2010, the Examiner rejected claims 76-85 under 35 U.S.C. § 101 as allegedly being directed to nonstatutory subject matter. The Examiner rejected claims 1, 3, 7-9, 11-17, 21-22, 24-29, 35-42, 66, 68-76, and 78-85 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,954,443 ("Tsirtsis") and in further view of U.S. Patent No. 7,170,863 ("Denman") and in further view of U.S. Patent App. Pub. No. 2003/0154243 ("Crockett"). The Examiner rejected claims 2, 5, 18-20, 33, 67, and 77 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tsirtsis in view of Denman and Crockett and in further view of U.S. Patent No. 7,418,509 ("Koskelainen"). The Examiner rejected claims 4, 6, 10, and 23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tsirtsis in view of Denman and Crockett and in further view of U.S. Patent App. Pub. No. 2002/0165969 ("Gallant").

2.   Response to Interview Summary Mailed December 10, 2010

On December 7, 2010, Tom Loos for the Applicant interviewed the Examiner via telephone.

Applicant asked the Examiner about the § 101 rejections of claims 76-85. The Examiner suggested amending claims 76-85 to recite a "non-transitory computer readable" medium. Applicant agreed to consider the Examiner's suggestion.

Regarding the § 103 rejections, Applicant argued that claim 1 recites "determin[ing] whether or not a push-to-talk communication is local to the first region based on the stored value of the local domain, set up a push-to-talk communication in the first region responsive to determining the push-to-talk communication is local, and set up the push-to-talk communication in the second region responsive to determining the push-to-talk communication is not local." In contrast, Applicant argued that Crockett describes routing based on locations of majority of users. The Examiner did not agree with Applicant. The Examiner suggested adding that the push-to-talk communication

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 SOUTH WACKER DRIVE
CHICAGO, ILLINOIS 60606
TELEPHONE (312) 913-0001

14

MBHB CASE NO.: 08-968
APPLICATION SERIAL NO.: 10/840,083
FILING DATE: MAY 6, 2004

was "originated by the first client." Applicant asked the Examiner if such an amendment would overcome the art; the Examiner did not commit to a position.

No other art, claims, or pertinent issues were discussed.

Applicant thanks the Examiner for sharing his time and expertise during the interview.

3. Status of the Claims

Previously, claims 30-32, 34, and 50-65 were cancelled and claims 43-49 were withdrawn. In this response, claims 1 and 76-85 have been amended as discussed herein and claims 6, 10, 18, 19, 29, and 66 have been amended to clarify their language. Now pending are claims 1-29, 33, 35-49, and 66-85, of which claims 1, 29, 43, 66, and 76 are independent claims, and the remainder are dependent claims.

The amendments to the claims are generally supported by the specification as filed, are made without prejudice or disclaimer, and solely made for the purposes of expediting prosecution. Applicant expressly reserves the right to pursue the subject matter of any previous claims in a continuation application.

4. Response to the Rejections under 35 U.S.C. § 101

As mentioned above, the Examiner rejected claims 76-85 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. In particular, the Examiner opined that "claim 76... is directed towards 'a tangible computer readable medium.' A claim directed towards such a 'medium', is not statutory if applicant does not specifically define the phrase in their specification as being only non-transitory mediums. The phrase therefore encompasses mediums such as signal waves over air or water, which is non-statutory subject matter, and the claim is therefore directed to non-statutory embodiments. Please see the Subject Matter Eligibility Memo, dated 27 January 2010 on the USPTO website for further information...." Office Action, pages 2-3.

As also mentioned above, during the interview of December 7, 2010, the Examiner suggested amending claims 76-85 to recite a "non-transitory computer readable" medium to address these rejections. Applicant disagrees with the analysis of

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, Illinois 60606
Telephone (312) 913-0001

15

MBHB Case No.: 08-968
Application Serial No.: 10/840,083
Filing Date: May 6, 2004

the term "computer-readable storage medium" set forth in the Office Action and in the Subject Matter Eligibility Memo cited by the Examiner. Nevertheless, solely to advance prosecution, Applicant has followed the Examiner's suggestion and amended the preambles of claims 76-85 to recite the adjective "non-transitory."

Applicant believes that these amendments to claims 76-85 overcome the rejections of claims 76-85 under 35 U.S.C. § 101. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejections of claims 76-85 under 35 U.S.C. § 101.

5.. Response to the Rejections under 35 U.S.C. § 103

As mentioned above, independent claims 1, 29, 66, and 76 are rejected under 35 U.S.C. § 103(a) over Tsirtsis in view of Denman and further in view of Crockett. Applicant submits that Tsirtsis, Denman, and Crockett, alone or in combination, do not support the rejections of claims 1, 29, 66, and 76 for at least the reasons presented below. Further, the Examiner did not establish a *prima facie* case of obviousness of claims 1, 29, 66, and 76 under M.P.E.P. § 2142 (requiring an Examiner to clearly articulate reasoning with rational underpinning to support the conclusion of obviousness).

a. Tsirtsis, Denman, and Crockett, alone or in combination, do not disclose or suggest all of the functionality recited in claim 1. Further, the Examiner has not made a *prima facie* case of obviousness for claim 1 under M.P.E.P. § 2142.

Amended claim 1 recites, in part, use of "a first client" of "a first plurality of clients in a first region," and a "first SIP proxy", where the "first client .... is configured to register with a second SIP proxy and optionally with the first SIP proxy", where "the first SIP proxy is ... configured to determine whether the first client is registered with the first SIP proxy, and, in response to determining that the first client is registered with the first SIP proxy: determine whether or not a push-to-talk communication originated by the first client is local to the first region based at least in part on the stored value of the local domain, set up a push-to-talk communication in the first region responsive to determining the push-to-talk communication is local, and set up the push-to-talk

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, Illinois 60606
Telephone (312) 913-0001

16

MBHB Case No.: 08-968
Application Serial No.: 10/840,083
Filing Date: May 6, 2004

communication in the second region responsive to determining the push-to-talk communication is not local." Support for these amendments may be found generally throughout the specification.

Applicant submits that the cited art not disclose or suggest at least this quoted functionality as recited in amended claim 1, and therefore does not support a rejection of claim 1 under 35 U.S.C. § 103.

The Examiner acknowledged that

> [t]he Tsirtsis/Denman system does not teach wherein the routing device stores a value of a local domain for the first region; or wherein a first client of the first plurality of clients is configured to register with the second routing device and optionally with the first routing device; wherein the first routing device is further configured to determine whether the first client is registered with the first routing device, and, in response to determining that the first client is registered with the first routing device: determine whether or not a push-to-talk communication is local to the first region based on the stored value of the local domain, set up a push-to-talk communication in the first region responsive to determining the push-to-talk communication is local, and set up the push-to-talk communication in the second region responsive to determining the push-to-talk communication is not local, and wherein, in response to a determination that the first client is not registered with the first routing device and is registered with the second routing device, the second routing device is configured to set up the push-to-talk communication in the second region.

Office Action, pages 5-6. Applicant agrees with this statement of the Examiner.

Crockett does not cure the acknowledged deficiencies in Tsirtsis and Denman. In particular, Crockett does not disclose or suggest at least "a first session initiation protocol (SIP) proxy configured to.... determine whether or not a push-to-talk communication originated by the first client is local to the first region based on the stored value of the local domain, set up a push-to-talk communication in the first region responsive to determining the push-to-talk communication is local, and set up the push-to-talk communication in the second region responsive to determining the push-to-talk communication is not local."

In an attempt to support the rejection of the above-quoted functionality of claim 1, the Examiner stated that "Crockett: [0105] provides for determining if call should be locally hosted, even if one target user is locally registered; for instance, even if first

McDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 SOUTH WACKER DRIVE
CHICAGO, ILLINOIS 60606
TELEPHONE (312) 913-0001

17

MBHB CASE NO.: 08-968
APPLICATION SERIAL NO.: 10/840,083
FILING DATE: MAY 6, 2004

target user is registered and determined as local, if majority of users and thus if the communication isn't going to be local, the setup may divert to another region...." Office Action, page 7.

Crockett describes use of a "regional dispatcher" that "may be the initial point of contact for the call setup requests and alert requests." Crockett, ¶ 0058. In particular, Crockett mentions that

> After the regional dispatcher has determined whether the call is intra-regional or inter-regional, it may start the process of determining which media control unit (MCU) may host the call. **For intra-regional calls, the regional dispatcher may assign the call to an MCU located in the same region as the regional dispatcher, if there are MCU resources available in that region. The resulting call using this type of call setup is referred to as a "locally-hosted" call, or local call.** For inter-regional calls, the regional dispatcher may have a choice to assign the call to an MCU within the same region or in a remote or foreign region. **The regional dispatcher may make this decision based on the users' location information to find the optimal path of travel for the IP packets containing media and signaling. If a majority of the users are located in a particular region, the call may be assigned to that region. If the users are evenly dispersed across regions, the call may be assigned to one of the regions containing the target users.** If the inter-regional call is assigned to an MCU in different region then the region in which the regional dispatcher resides, the call is referred to as a "remotely-hosted" or remote call. The regional dispatcher may have knowledge of the network topology and/or connectivity between the MCUs and the PDSNs they are serving and may use this knowledge to make a better decision on the assignment of calls.

Crockett, ¶ 0105 (emphasis added). *See also* Crockett, ¶ 0111.

That is, while Crockett does mention the concept of a "locally-hosted" call, the decision on call assignment is based on where "**a majority of the users are located**" or "**[i]f the users are evenly dispersed across regions, the call may be assigned to one of the regions containing the target users.**" Crockett, ¶ 0105 (emphasis added). That is, Crockett discloses the call is assigned to where the majority of users are, regardless of whether the call is locally-assigned or remotely-hosted.

In contrast, claim 1 recites "set[ting] up a push-to-talk communication originated by the first client in the first region responsive to determining the push-to-talk communication is local" and "set[ting] up the push-to-talk communication in the second

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 SOUTH WACKER DRIVE
CHICAGO, ILLINOIS 60606
TELEPHONE (312) 913-0001

18

MBHB CASE NO.: 08-968
APPLICATION SERIAL NO.: 10/840,083
FILING DATE: MAY 6, 2004

region responsive to determining the push-to-talk communication is not local." That is, claim 1 recites that locality (*i.e.,* "local" or "not local" as recited in claim 1) of a push-to-talk communication originated by the first client, not the location of the majority of users as disclosed by Crockett, determines a region for a push-to-talk communication. For at least these reasons, Crockett does not cure the above-mentioned deficiencies in Tsirtsis and Denman.

Applicant submits that Tsirtsis, Denman, and Crockett, alone or in combination, do not disclose or suggest all of the functionality recited in claim 1. Applicant further submits that the Examiner did not establish a *prima facie* case of obviousness of claim 1 under M.P.E.P. § 2142. Thus, Applicant submits that the cited art does not support rejection of independent claim 1 under 35 U.S.C. § 103.

b.   For at least the reasons presented for claim 1, Tsirtsis, Denman, and Crockett, alone or in combination, do not support the rejections of independent claims 29, 66, and 76 under 35 U.S.C. § 103. Further, the Examiner has not made a *prima facie* case of obviousness for claims 29, 66, and 76 under M.P.E.P. § 2142.

Independent claims 29, 66, and 76 stand rejected under 35 U.S.C. § 103 over Tsirtsis in view of Denman and in further view of Crockett. As amended, claims 29, 66, and 76 recite similar functionality to that discussed above for independent claim 1. Thus, for at least the reasons set forth for claim 1, Applicant submits that the proposed Tsirtsis/Denman/Crockett combination does not support rejection of independent claims 29, 66, and 76 under 35 U.S.C. § 103.

Applicant further submits that the Examiner did not establish a *prima facie* case of obviousness of claims 1, 29, 66 and 76 under M.P.E.P. § 2142.

For at least these reasons, Applicant respectfully requests the Examiner reconsider and withdraw the rejections of claims 1, 29, 66, and 76 under 35 U.S.C. § 103.

c.   Applicant respectfully requests the Examiner withdraw the rejections of the dependent claims as well, for at least the reasons provided above.

Further, Applicant submits that the revisions and comments directed above to independent claims 1, 29, 66, and 76 apply equally to dependent claims 2-28, 33, 35-42,

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, Illinois 60606
Telephone (312) 913-0001

19

MBHB Case No.: 08-968
Application Serial No.: 10/840,083
Filing Date: May 6, 2004

67-75, and 77-85, each of which depend directly or indirectly from claims 1, 29, 66, and 76. On at least this basis, the Applicant requests reconsideration and withdrawal of the rejections of dependent claims 2-28, 33, 35-42, 67-75, and 77-85. Some of these dependent claims stand rejected under § 103 in view of certain other references. However, the Applicant submits that these other references do not cure the deficiencies of the proposed Tsirtsis/Denman/Crockett combination.

Further, Applicant submits that the Examiner did not establish a *prima facie* case of obviousness of claims 2-28, 33, 35-42, 67-75, and 77-85 under M.P.E.P. § 2142.

Therefore, Applicant respectfully requests the Examiner reconsider and withdraw the rejections of claims 2-28, 33, 35-42, 67-75, and 77-85 under 35 U.S.C. § 103.

5.   Conclusion

In view of the foregoing, Applicant submits that all stated rejections have been addressed, and thus Applicant respectfully requests reconsideration and withdrawal of these rejections. The Examiner is invited to call the undersigned attorney at 312-913-3338 to expedite prosecution of this application.

Respectfully submitted,

**McDonnell Boehnen
Hulbert & Berghoff LLP**

Date: <u>January 25, 2011</u>   By: <u>/Thomas J. Loos/</u>
                                                Thomas J. Loos
                                                Reg. No. 60,161

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, Illinois 60606
Telephone (312) 913-0001

20

MBHB Case No.: 08-968
Application Serial No.: 10/840,083
Filing Date: May 6, 2004